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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): William T. Carpenter

Serial No.: 09/773,815

Examiner: Kreck, John J.

Filing Date: January 31, 2001

Group Art Unit: 3673

Title: Method of Modifying the Axis of Rotation of the Earth

MS Appeal Brief - Patents
Commissioner for Patents
Alexandria VA 22313-1450

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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on April 15, 2003.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. 1.192(c)):

- I. Real Party Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
 - A. Rejections under 35 U.S.C. 103(a)
 - B. Conclusion
- IX. Appendix of claims involved in the appeal

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The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is William T. Carpenter, a U.S. citizen and resident of Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There is a total of 10 claims in the application, which are identified as claims 11-20.

B. Status of All the Claims

1. Claims canceled: Claims 1-10.
2. Claims withdrawn from consideration but not canceled: NONE.
3. Claims pending: Claims 11-20.
4. Claims allowed: NONE.
5. Claims rejected: Claims 11-20.

C. Claims on Appeal

The claims on appeal are: Claims 11-20.

IV. STATUS OF AMENDMENTS

Appellant filed a Response after Final Rejection dated December 18, 2002. No amendments to the claims were presented. Appellant also presented arguments traversing the final rejection of the claims. The Examiner responded to Appellant's Response after Final Rejection with an Advisory Action dated March 19, 2003, in which the Examiner stated that the response had been considered, but did not place the application in condition for allowance.

V. SUMMARY OF INVENTION

This invention is a method of modifying the earth-rotation vector in relation to the body of the planet or in inertial space by redistributing the mass in/or/on the crust of the earth. Such

redistribution will change the center of mass of the Earth thereby causing a change in the earth-rotation vector.

VI. ISSUE

The issue remaining is whether claims 11-20 are unpatentable under 35 U.S.C. § 103(a) over Chao, B.F., Anthropogenic impact on global geodynamics due to water impoundment in major reserves, *Geophys. Res. Lett.*, 22, 3529-3532, 1995 (hereinafter "Chao").

VII. GROUPING OF CLAIMS

For purposes of this Appeal Brief only, the claims have been grouped as follows:

Group I Claims 11-13, 15-20.

Group II Claim 14.

The claims do not stand or fall as a group. Appellant has included reasons for the separate patentability of each delineated group in Section VIII, Arguments, herein.

VIII. ARGUMENTS

The Examiner rejected claims 11-20 as unpatentable over Chao. While the Examiner acknowledged that Chao does not explicitly teach the claimed steps, the Examiner stated that those steps would be obvious to one of ordinary skill in the art at the time of the invention.

A Prima Facie Case of Obviousness Has Not Been Established

Without a *prima facie* case of obviousness, any rejection under 35 U.S.C. § 103 is improper and should be overturned. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the Examiner must satisfy three basic criteria. First, the Examiner must demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success. Finally, the Examiner must show that the cited prior art teaches or suggests all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

"[W]hen obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). That showing must clearly and particularly identify a suggestion,

teaching, or motivation to modify the cited reference. *See In re Dembiczak*, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). In the final action mailed December 18, 2002, the Examiner mistakenly claims that “it is clear that Chao recognizes the problem addressed by the claimed invention” and that “Chao implicitly suggests that the problem should be corrected.” However, Chao merely describes the effects of certain human activity on length-of-day, polar motion, and low-degree gravitational coefficients. Chao does not, explicitly or implicitly, suggest that any problem exists, and the Examiner has failed to clearly and particularly identify any portion of Chao that does so. Rather, Chao exemplifies the problem identified by the inventor in the present application’s disclosure. Reading Chao in light of the present disclosure impermissibly employs hindsight and uses the present inventor’s own disclosure against him.

Further, the Examiner’s analogy to ozone depletion and species endangerment is misplaced. The cited excerpts from the Encyclopaedia Britannica do not teach or suggest that the anthropogenic effects described in Chao (i.e., changes in length-of-day, polar motion, and low-degree gravitational coefficients) present any problem to be solved, and they do not provide any motivation to practice the claimed steps.

Even if the problem were obvious, the claimed steps to solve it are not. In the final rejection, the Examiner admits that “[t]he claimed steps are not explicitly disclosed by Chao,” but the Examiner has not identified with particularity any teaching, suggestion, or motivation to alter the scholarly description in Chao to include the claimed steps. Rather, the Examiner makes only conclusory statements that each claimed step would be obvious in the disclosure of Chao, taken as a whole, because it is an environmental problem and it is well known to correct environmental problems caused by man.. However, the Examiner fails to make the required showing as to how Chao teaches or suggests the claimed invention. *See Dembiczack*, 175 F.3d at 1000 (“Yet this . . . analysis fails to demonstrate how the . . . references teach or suggest their combination . . . to yield the claimed invention.”) As described above, the excerpts from the Encyclopaedia Britannica lend no motivation. Without having read the present inventor’s disclosure, there simply is no suggestion or motivation in the cited references to practice the invention taught in that disclosure.

Further, with respect to claim 14, Chao deals exclusively with the effects of water impoundment in certain major reserves. Chao does not disclose redistributing solid material to alter the earth’s rotational axis, and the Examiner has not clearly and particularly identified any

teaching, suggestion, or motivation to alter Chao's disclosure in such a way. No cited reference supports the Examiner's comment in the Final Action of December 18, 2002, that "it would have been further obvious to one of ordinary skill at the time of the invention . . . because solid substances are less likely to move over time," and the Examiner has not clearly and particularly identified any motivation to combine that observation with Chao.

Conclusion

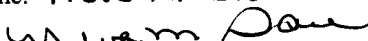
Because no *prima facie* case of obviousness has been made, Appellant respectfully submits that claims 11-20 are patentable under 35 U.S.C. § 103(a). Therefore, reversal of the rejection is courteously solicited.

IX. APPENDIX OF CLAIMS

The text of the claims involved in the appeal are:

11. A method of modifying the axis of rotation of a planet comprising the steps of:
 - measuring the mass of a planet;
 - determining the center of mass of the planet;
 - characterizing the axis of rotation of the planet;
 - selecting a desired character of rotation;
 - calculating a moment of stability required to cause the desired character of rotation;
 - determining a position and a mass of a compensating substance sufficient to effect the moment of stability; and
 - positioning the mass in the position.
12. The method of claim 11 in which the position of the compensating substance is positioned an underground cavity.
13. The method of claim 11 in which the position of the compensating substance is positioned in an above ground cavity.
14. The method of claim 11 in which the substance is solid.
15. The method of claim 11 in which the substance is a liquid.
16. The method of claim 12 in which the substance is a liquid.
17. The method of claim 13 in which the substance is a liquid.
18. The method of claim 15 in which the liquid is water.
19. The method of claim 16 in which the liquid is water.
20. The method of claim 17 in which the liquid is water.

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